

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

**John CAIRNEY, et al.**

Serial No.: 09/973,994

Filed: October 11, 2001

For: DIFFERENTIALLY-  
EXPRESSED CONIFER  
cDNAs, AND THEIR USE IN  
IMPROVING SOMATIC  
EMBRYOGENESIS

Group Art Unit: 1638

Examiner: Not Yet Assigned

#7  
Plunkett  
5/6/02  
STH (152)  
7/3/02

**RECEIVED**

JAN 24 2002

Commissioner for Patents and Trademarks  
Washington, DC 20231


Sir:

TRANSMITTAL LETTER

TECH CENTER 1600/2900  
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JUL - 3 2002  
LICENSING & REVIEW

Please find enclosed a reply to the Official Notice of Licensing and Review we received on December 20, 2001 for this matter. Specifically the Notice indicates that this application may relate to special nuclear material or atomic energy as recited in 42 U.S.C. 2182 (Department of Energy). Provided in this response are signed declarations from both inventors stating that their invention is not related to special nuclear material or atomic energy. The mailing date of the Notice was December 13, 2001, accordingly, our reply is timely within the 45 day time frame.

Dated: January 22, 2002

  
Robert A. Pollock  
Reg. No. 43,008

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
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The following is an example of an acceptable property rights statement. Statements of this type are, of course, only suitable for situations in which NO Agency funds or other considerations were involved in the making or conception of the invention. While this example is in the form of a declaration, a sworn document is equally acceptable.

I (we) Nanfei Xu

citizens of Canada

residing at 2480 Hickory Manor Dr, Wildwood, MO 63011 USA

declare:

That I (we) made and conceived the invention described and claimed in patent application:

JAN 2 4 2001

TECH CENTER 1600/23

Serial Number 09/973994 filed in the United States of America on Oct. 11, 2001

titled Differentially-Expressed Conifer cDNAs and Their use in Improving Somatic Embryogenesis

(Check and complete either I or II below)

(Check III and/or IV below as appropriate)

☒ I. (For Inventors Employed by an Organization) That I (we) made and conceived this invention while employed by Institute of Paper Science and Technology. That the invention is related to the work I am (we are) employed to perform and was made within the scope of my (our) employment duties; That the invention was made during working hours and with the use of facilities, equipment, materials, funds, information and services of IPST (name of employer). Other relevant facts are \_\_\_\_\_

That to the best of my (our) knowledge and belief (and/or based upon information provided by \_\_\_\_\_ of \_\_\_\_\_:

—OR—

☐ II. (For Self-Employed Inventors) That I (we) made and conceived this invention on my (our) own time using only my (our) own facilities, equipment, materials, funds, information and services. Other relevant facts are \_\_\_\_\_

That to the best of my (our) knowledge and belief:

☒ III. The invention was not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors: Energy Research and Development Administration or the Department of Energy.

—AND/OR—

☐ IV. The invention was not made, conceived or first actually reduced to practice) under nor is there any relationship of the invention to the performance of any work under any contract of the National Aeronautics and Space Administration.

→ My research for invention 09/973994 was and is not useful in the production or utilization of special nuclear material or atomic energy.

The undersigned inventor(s) declare further that all statements made herein of his or her (their) own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's Signature: Nanfei Xu

Post Office Address: 2480 Hickory Manor Dr, Wildwood, MO 63011 USA

Date: 01/09/2002

Inventor's Signature: \_\_\_\_\_

Post Office Address: \_\_\_\_\_

Date: \_\_\_\_\_

JOYCE H. KREBS

NOTARY PUBLIC - STATE OF MISSOURI

MY COMMISSION EXPIRES 8/10/2002

ST. LOUIS COUNTY

Joyce H. Krebs  
On this 9th day of January 2002  
Nanfei Xu, Inventor

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DEC 29 2001



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

FINNEGAN, HENDERSON,

FARABOW, GARRETT & DUNNER, L.L.P.

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/973,994	10/11/01	Cairney, et al.	07648.0023-00

Finneegan, Henderson, Farabow,  
Garrett & Dunner, L.L.P.  
1300 I Street, N.W.  
Washington, DC 20005-3315

EXAMINER	
ART UNIT	PAPER NUMBER
	4

DATE MAILED:

DEC 13 2001 4

IF NO RESPONSE TO THIS NOTICE IS RECEIVED WITHIN FORTY-FIVE DAYS, A  
FORMAL REQUIREMENT WILL BE ISSUED

The subject matter of this application appears to:

☒ be "useful in the production or utilization of special nuclear material or atomic energy" as recited in 42 U.S.C. 2182 (Department of Energy (DOE)).

☐ "have significant utility in the conduct of aeronautical and space activities" as recited in 42 U.S.C. 2457 (National Aeronautics and Space Administration (NASA)).

Accordingly, no patent can issue on this application unless applicant(s) file a statement (under oath or in the form of a declaration as provided by 37 CFR 1.68) setting forth (1) the full facts concerning the circumstances under which the invention was made and conceived and (2) the relationship (if any) of the invention to the performance of any work under any contract or other arrangement with the Agency(ies) noted above. On the reverse side of this form is an example of an acceptable format for this statement. The language appearing in paragraphs III and/or IV of the example *must* appear if applicant is attempting to establish that no relationship (under item 2 above) exists.

If the invention disclosed in this application was developed under a contract, grant or cooperative agreement between the Agency indicated above and a person, small business or non-profit organization and rights to the invention have been determined by specific reference to 35 U.S.C. 202 in the contract, grant or cooperative agreement, then applicant need not submit the statement described above. Instead, applicant may file a verified statement (under oath or in the form of a declaration, 37 CFR 1.68) setting forth the information required by 35 U.S.C. 202(c)(6).

IF NO STATEMENT HAS BEEN RECEIVED WITHIN FORTY-FIVE DAYS OF THE MAIL DATE INDICATED ABOVE, a formal requirement for statement will then be issued. No provision is made for extension of the statutory thirty-day period for response to the formal requirement and the penalty for failure to file an acceptable and timely statement is abandonment of the application. Therefore, applicants are strongly encouraged to submit a statement at this time in order to avoid the issuance of a formal requirement.

IT IS IMPORTANT TO NOTE that the statement must accurately represent the property rights situation of the claimed invention if and when the application is found allowable. Thus, if during prosecution before the examiner, the claimed invention is so altered or the property rights situation so changed as to impact the accuracy of a statement submitted earlier, a supplemental statement must be filed. Failure to submit such additional information where appropriate may be considered a false representation of material facts and render the patent owner vulnerable to loss of patent rights and other sanctions as set forth in the statutes. The PTO will not review allowed applications for this possibility. The responsibility for complying with the statutes rests with the applicants.

Any questions regarding this requirement should be directed to Licensing and Review at (703) 306-4191.

PLEASE DIRECT ALL COMMUNICATIONS RELATING TO THIS MATTER TO THE  
ATTENTION OF LICENSING AND REVIEW

I (We) John Cairney  
Citizens of Unites States of America  
residing at 2611 Fox Hills Drive, Decatur GA 30033

declare:

That I (we) made and conceived the invention described and claimed in patent application:  
Serial Number 09/973,994 filed in the United States of America on October 11, 2001 titled  
Differentially-Expressed Conifer cDNAs, and Their Use in Improving Somatic  
Embryogenesis

(Check and complete either I or II below)

☒ I. (For Inventors Employed by an Organization) That I (we) made and conceived this invention while employed by Institute of Paper Science and Technology. That the invention is related to the work I am (we are) employed to perform and was made within the scope of my (our) employment duties; That the invention was made during working hours and with the use of facilities, equipment, materials, funds, information and services of Institute of Paper Science and Technology. Other relevant facts are \_\_\_\_\_

That to the best of my (our) knowledge and belief (and/or) based upon information provided by \_\_\_\_\_ of \_\_\_\_\_:

-OR-

☐ II. (For Self-Employed Inventors) That I (we) made and conceived this invention on my (our) own time using only my (our) own facilities, equipment, materials, funds, information and services. Other relevant facts are \_\_\_\_\_

The undersigned inventor(s) declare further that all statements made herein of his or her (their) own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Inventor's Signature: John Cairney

Post Office Address: 2611 Fox Hills Drive, Decatur GA 30033

Date: 1/10/02

(Check and complete either III or IV below)

That to the best of my (our) knowledge and belief:

☒ III. The invention was not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commissions or its successors: Energy Research and Development Administration or the Department of Energy.

-AND/OR-

☒ IV. The invention was not made (conceived or first actually reduced to practice) under or is there any relationship of the invention to the performance of any work under any contract of the National Aeronautics and Space Administration.

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